

## REMARKS AND ARGUMENTS

Claims 1, 3-8 and 10 are pending in the present application, of which claims 1 and 6 are independent. Claims 2 and 9 have been canceled. Claims 1, 3, 4, 6-8 and 10 have been amended. Support for the additions to claims 1, 3, 4 and 6-8 is found in the specification as follows: limitations on DCOIT content – page 3, lines 2-3; limitations on solvent content – page 3, lines 8-9; limitation on total amount of inorganic filler – page 4, lines 1-2.

Applicants hereby affirm the election to prosecute the species 4,5-dichloro-2-octyl-3(2H)-isothiazolone (“DCOIT”). Claims 1 and 6 were rejected under 35 U.S.C. § 112, first and second paragraphs for reasons Applicants believe to be moot in view of the present amendments limiting the claims to DCOIT.

Claims 1-3 and 6-7 were rejected under 35 U.S.C. § 102(b) as anticipated by Mattox (EP 490,565). Applicants respectfully traverse this rejection.

As described in the Office Action, Mattox discloses broad concentration ranges for isothiazolones and copper salts in aqueous media. However, Mattox exemplifies only a paint formulation containing just 900 ppm (0.09%) of DCOIT, very close to the lower limit of the broad concentration range disclosed therein. There simply is no specific teaching anywhere in Mattox of a composition containing a high level of DCOIT in combination with a low level of organic solvent. In contrast, the present claims recite a composition containing 15-30% DCOIT, as recited in claims 1 and 6, or 18-25% DCOIT, as recited in claims 3 and 7, in combination with no more than 5% organic solvent. Accordingly, Mattox does not disclose the limitations of the present claims, and the rejection should be withdrawn.

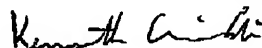
Moreover, even if Mattox suggested formulating higher amounts of DCOIT with very little solvent, there is no direction that could enable one to make such a formulation. References must provide an enabling disclosure that allows one of skill in the art to reproduce the disclosed subject matter without undue experimentation. *See* M.P.E.P. § 2121.01. Therefore, for this reason as well, Mattox cannot anticipate the present invention, and the rejection should be withdrawn.

Claims 1-8 were rejected under 35 U.S.C. § 103(a) as unpatentable over Mattox in view of Payne et al. (WO 95/00019, “Payne”). Claims 1-10 were rejected under 35 U.S.C. § 103(a) as unpatentable over Mattox in view of Payne, in view of Kostansek et al. (EP 1,060,667, “Kostansek”), in view of Gerigk et al. (US 5,332,430, “Gerigk”). Applicants respectfully traverse these rejections.

As discussed above in connection with the anticipation rejection, Mattox does not disclose the limitations recited in the present claims. Applicants respectfully submit that Mattox also fails to render the present invention obvious, alone or in combination with the other cited references. There is no disclosure in Mattox related to formulations containing high levels of DCOIT in combination with low levels of organic solvent, nor is there any suggestion to modify its disclosures to produce such a formulation, as is required to establish a *prima facie* case of obviousness. See M.P.E.P. § 2143.01. The other references also fail to teach these limitations, having been cited only for their alleged disclosure of other claim limitations. Moreover, the references do not provide one skilled in the art with a reasonable expectation of success in producing Applicants' claimed stable formulation, as required by M.P.E.P. § 2143.02. Accordingly, the cited references cannot render the invention obvious, and the rejection should be withdrawn.

Applicants believe that the foregoing amendments and arguments have overcome the rejections. However, if the Examiner has any further objections to the application, Applicants respectfully request that the Examiner contact Applicants' undersigned attorney by telephone at (847) 649-3891 to discuss the remaining issues.

Respectfully submitted,



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